



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application

Applicant: JOSEPH HUMMEL
Serial No.: 08/424,223
Filing Date: April 19, 1995
Docket No.: 10-142C3
Title: KNITTABLE YARN AND SAFETY APPAREL

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OFFICE OF PATENTS

Unit:

Examiner: J.

PATENT & ACCOUNTABILITY	
REPORT ADJUSTED	
23	0630
FEE	VALUE
3503	PLUNGED
722	130.00
Hail	

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Assistant Commissioner for Patents
Washington, D.C. 20231

GROUP 3500

Petition under Rule 37 C.F.R. § 1.181

Dear Sir:

Applicant petitions the Commissioner of Patents and Trademarks to exercise his supervisory power and withdraw the finality of the first Office action in this application mailed on August 18, 1995. It is submitted that the final rejection is premature.

Facts

This is a continuation application filed to obtain reconsideration of claims finally rejected in the parent. The examiner acted on the application and issued a first action final rejection of the claims. The examiner justifies the final rejection on the basis that the claims are drawn to the same invention claimed in the earlier application and could have been finally rejected in a next action if they had been entered there, citing M.P.E.P. 706.07(b). Actually, the parent was under final rejection, the claims were already entered, and would not have been

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Assistant Commissioner for Patents, Washington, D.C. 20231

on September 25, 1995.

By: Ellen M. Gyzek

reconsidered in the parent application if a new issue was raised that required reconsideration.

A declaration under 37 CFR 1.132 was submitted with the continuation application, attesting to facts showing the unobviousness of the invention over the prior art.

Applicant realized that the declaration would raise a new issue requiring further consideration if submitted in the parent application and elected to voluntarily file a continuing application to present it. Further, in view of the inadvertent abandonment and revival of the parent, no time was available to file a response after final or to have it considered if filed.

Points to be Reviewed

Is the examiner's rationale for the final rejection applicable to this situation?

Is the first action final rejection premature?

Argument

The examiner's rationale for the final rejection is not applicable to the present factual situation. M.P.E.P. 706.07 indicates a first action final is not proper where the application contains material presented after final rejection but denied entry because new issues were raised that required further consideration. Under the facts here, applicant was foreclosed from presenting the material after final rejection upon revival of the application. Rather a continuation application was required.

Applicant submitted with this continuation application a declaration under Rule 132 attesting to the unobviousness of the claimed invention and a communication explaining the declaration and why the additional evidence shows unobviousness. Thus, while the claims may be the same as previously considered, the issue presented is different because of the new evidence presented for the examiner's consideration. This issue has not been previously considered and thus applicant has had no opportunity to respond to the examiner's initial consideration.

Never presented in parent, don't make presumptions

on what basis was determination made?

Nothing denied entry

This was done by closer appl. Not

The examiner's action, if it reflects appropriate procedure, means that any application refiled to submit evidence not previously submitted in the parent case, cannot obtain the minimum consideration accorded a continuation application in which the information was submitted after final rejection and refused consideration as raising a new issue.

In this case, not only was the final action in the parent premature and applicant's contention to that effect ignored, but the impropriety has been compounded by this premature final rejection.

The examiner raises questions with respect to the evidence presented in the declaration, specifically as to the procedures and yarn constructions tested. By concurrently making the action final, the examiner is taking the position that an issue has been reached. This position is inconsistent and illogical in view of his questions. Applicant refiled this application at considerable expense to obtain consideration of evidence that he believes shows unobviousness of the claimed invention over the art relied upon by the examiner. Surely applicant is entitled to respond to the examiner's questions and clarify the procedures and constructions that have caused the examiner to deem the declaration not persuasive, and should be allowed to do so without being under the constraints of a first action final rejection. A response by applicant to clarify the evidence expedites the prosecution by either overcoming the rejection, or by placing the application in better condition for appeal. To force an appeal with unanswered questions, or to require applicant to pay a new fee to save the term of his patent while answering the examiner's concerns over the declaration is onerous and not justified by the facts.

Withdrawal of the finality of the Office action mailed August 18 is appropriate so applicant can clarify the nature of the evidence submitted by responding to the examiner's questions without the constraints of a final rejection

applied in the first action.

The Commissioner is hereby authorized to charge any fees which may be required to Deposit Account No. 23-0630. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

Sept 25, 1995
Date

James G. Watterson
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Reg. No.: 20,180

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